



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/693,908 10/23/00 HERMONAT

P 023533/0130

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HM22/1001

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EXAMINER

PURI, B

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

10/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

## Office Action Summary

Application No.

09/693,908

Applicant(s)

HERMONAT, PAUL L.

Examiner

Beena Puri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-45 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

**Group I**, claim (s) 13 -18, a fusion proteins derived from wild type AAV Rep 78 and pharmacological composition for fusion proteins.

**Group II**, claim (s) 1-20 drawn to Rep78 mutants and fusion proteins derived from different AAV Rep78 mutants, a method of selection for mutants and pharmacological composition for mutant or fusion proteins.

**Group III**, claim (s) 21-39 DNA constructs for wild type AAV Rep78 protein, pharmaceutical composition and a method of producing adenovirus.

**Group IV**, claim (s) 21-39 DNA constructs of different mutants including regulatable promoter elements providing the binding site for the AAV Rep78 protein, pharmacological composition for DNA constructs and a method of producing recombinant virus from mutants.

**Group V**, claims 40-43 are regulatory elements of AAV Rep78 and the remaining promoter sequences from a promoter other than the HPV-16p97 promoter.

**Group VI**, claims 44-45 are mutant that possess different biochemical and biological function as compared to the wild-type AAV Rep78 protein.

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**Group VII**, claim (s) 30-31, 38-39 a method of treating a papillomavirus-associated disease, cancer or HIV-associated disease using DNA constructs.

2. The inventions listed as groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I and II are two different kinds of fusion proteins: a) derived from wild type of AAVRep78; b) derived from AAVRep78 mutants. Group III is a method of using fusion proteins for treating papillomavirus-associated disease, cancer or HIV-associated diseases. Group IV and V are for DNA sequences of the constructs comprising wild type AAV Rep78 genome and different mutants derived from AAV Rep78 genome. Group VI is a method of treating the disease using the DNA construct. The products of each group have separate and distinct methods of use and modes of action.

3. Applicant is advised that the response to this requirement to be completed must include an election of the invention to be examined.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beena Puri, Ph. D. whose telephone number is (703) 306-0284. The examiner can normally be reached on 8:00 a.m. EST. to 4:30 p.m. EST.

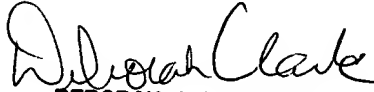
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Deborah Clark, can be reached on (703) 305-4051. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Beena Puri, Ph.D.  
Patent examiner  
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bp  
September 26, 2001

  
DEBORAH J. R. CLARK  
SUPERVISORY PATENT EXAMINER  
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